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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/714,320

11/15/2000

Matias Duarte

04676.P004X

6475

7590

11/16/2005

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EXAMINER

KUMAR, SRILAKSHMI K

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/714,320	Applicant(s) DUARTE ET AL.	
	Examiner Srilakshmi K. Kumar	Art Unit 2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ✓ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6,8,16,21-27 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,8,16,21-27 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The following office action is in response to amendment filed June 27, 2005. Claims 1, 3, 6, 8, 16, 21-27, 31-35 are pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 6, 8, 16, 21-27, 31-35 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/718,742. Although the conflicting claims are not identical, they are not patentably distinct from each other as is shown below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Application 09/714320	Application 10/718,742
<p>Claim 1: An apparatus comprising; a data processing device; a first group of control elements and a second group of control elements integrated directly on said data processing device;</p> <p>A display comprising a display area for rendering images generated by said data processing device, said display coupled to said data processing device at a pivot point and rotatable around said pivot point from a first position to a second position, wherein said display is viewable in both said first position and said second position and wherein both said first and second groups of control elements are exposed when said display is in said second position, and wherein only said second group of control elements are exposed when said display is in said first position,</p>	<p>Claim 1: A data processing apparatus comprising; a body having a surface defining a first plane, the body comprising a first group of control elements and a second group of control elements for entering data and performing control operations;</p> <p>A display having a display area defining a second plane, the display coupled to the data processing apparatus at a pivot point and rotatable around the pivot point from a first position to a second position, wherein the display is viewable in both the first position and the second position and wherein both the first and second groups of control elements are exposed when the display is in the second position, and wherein only the second group of control elements are exposed when the display is in the first position, wherein the first plane and the second plane are substantially parallel when the display is in the first position, and</p>

	wherein the first plane and the second plane are not parallel when the display is in the second position.
Wherein said first group of control elements are covered by said display when said display is in said first position and said second group of control elements are not covered by said display when said display is in said first position; and	Claim 3: wherein the first group of the control elements are covered by the display when the display is in the first position. Claim 5: wherein the second group of control elements are not covered by the display when the display is in the first position
Wherein said second group of control elements comprise a control knob and a set of control buttons; and	Claim 6: wherein the second group of control elements comprise a control knob and a set of control buttons
A switch configured to trigger when said display is rotated from said second position to said first position.	Claim 8: a switch configured to trigger when the display is rotated from the second position to the first position

While the claim limitations are not exactly the same, it would have been obvious to one of ordinary skill in the art where the limitations are claiming similar subject matter, and therefore

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would not be not patentably distinct because the examined application claim is either anticipated by, or would have been obvious over, the reference claim. The double patenting comparison table is shown for only claim 1, but is applied to all other pending claims, therefore all pending claims are rejected under obvious provisional double patenting.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 26, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Conway et al. (US 5,278,779).

As to independent claim 26, Conway et al disclose an apparatus comprising, a data processing device (Figs. 1a-d); a first group of control elements (Figs. 1a-d, items on the left) and a second group of control elements (Figs. 1a-d, items on the right) integrated directly on said data processing device; a display (Fig. 1, item 14) comprising a display area for rendering images generated by said data processing device, said display coupled to said data processing device (Fig. 1, item 10) at a pivot point and rotatable around said pivot point from a first position to a second position (Figs. 1a-c, where each figure shows the rotation of the display and col. 2, lines 31-36); wherein said display is viewable in both said first position and said second position (Figs. 1a-c), and wherein both said first and second groups of control elements (Fig. 1a, items on 12A and 12B, respectively) are exposed when said display is in said second position (Fig. 1a), and wherein only said second group of elements are exposed when said display is in said first

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position (Figs. 1b-c); wherein said first group of control elements are covered by said display when said display is in said first position (Fig. 1b-c, items on 12A), and said second group of control elements are not covered by said display when said display is in said first position (Figs. 1b-c, items on 12B); and wherein said second group of control elements comprise a control knob and a set of control buttons (Fig. 1b, items on 12B, specifically the keys and the circular knob); and wherein said second position is inverted with respect to said first position (Figs. 3a-d).

As to dependent claim 27, limitations of claim 26, and further comprising, wherein said display is rotatably coupled to said data processing device and configured to rotate within a plane substantially perpendicular to said display's axis of rotation between said first position and said second position (Figs. 1a-c, shows the rotation of the display (14)).

As to dependent claim 31, limitations of claim 26, and further comprising, Conway discloses in other embodiments of the apparatus (Figs. 3a-d), where the second position is inverted with respect to said first position, thus showing the images inverted relative to said display.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conway et al. (US 5,278,779).

As to dependent claim 35, limitations of claim 26, and further comprising, Conway fails to explicitly disclose wherein the control knob is configured to scroll between menu items and/or data, the apparatus further comprising control buttons configured to select the menu items and/or data when said display is in both said first position and said second position. However, Conway discloses in col. 1, lines 16-20, where computer keyboards are well known, and typically consist of a flat, generally rectangular rigid "slab" bearing one hundred or more keys, including standard letter keys, number keys, punctuation keys, function keys, and others. Therefore, it would have been obvious to one of ordinary skill in the art to include a button configured to select items within the list as in col. 1, lines 16-20 Conway discloses function keys which are well known to be programmable and aid in enhancing user navigation within the apparatus.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3, 6, 8, 16, 21-27, 31-35 have been considered but are moot in view of the new ground(s) of rejection.

With respect to independent claims 1 and 16, applicant has amended these claims to include allowable subject matter. With respect to independent claim 26, in an interview on November 9, 2005 with the applicant's representative, applicant's representative authorized an examiner's amendment to include allowable subject matter. During an interference search, the examiner discovered application 10/718,742 with same assignee and similar inventors, therefore as shown above, a provisional double patenting rejection is issued for claims 1, 3, 6, 8, 16, 21-27, and 31-35. Applicant can overcome the double patenting rejection by filing a terminal disclaimer, and can, also, overcome the art rejection of claims 26, 27, 31 and 35 by amending claim 26 as discussed in the interview.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srilakshmi K. Kumar whose telephone number is 571 272 7769. The examiner can normally be reached on 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Srilakshmi K. Kumar
Examiner
Art Unit 2675

SKK
November 14, 2005


CHANH NGUYEN
PRIMARY EXAMINER